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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,496	04/25/2001	Mark Ashby	032005-092	9267

7590 09/02/2003
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EXAMINER

DRUAN, THOMAS J

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 09/02/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,496

Applicant(s)

ASHBY ET AL.

Examiner

Thomas J. Druan, Jr.

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3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 10. 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Applicant's amendment received on 09 June 2003.

Election/Restrictions

2. Applicant's election of Group I, claims 1-17 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Applicant's election with traverse of Species A in Paper No. 9 is acknowledged. The traversal is on the ground(s) that "claims 1 and 11 have numerous interrelated portions," and are thus not distinct; and further that the examiner did not provide reasons and/or examples to support the restriction requirement; and lastly that "37 [CFR] 1.141 provides that a reasonable number of species may still be claimed in one application." This is not found persuasive because firstly, the required species election was not between claims 1 and 11, but between "Species A as in Figure 4" and "Species B as in Figure 8." The examples in support of the restriction requirement are the species depicted in Figures 4 and 8, and as a picture is worth a thousand words, the examiner submits that there is enough information in those two figures to distinguish differences between them. In fewer than a thousand words, at least some differences are that the device of Figure 4 comprises a base with an opening and a flap with the perimeter of the flap defining a cutting edge which cooperates with the opening to perform a cutting action resulting in a single cut product, making the flap a cutting element; however, Figure 8 portrays a device that has a base with several openings and

a flap having several depending structures wherein the depending structures mate with the openings to perform a cut resulting in several cut products, with the flap acting as a driving member to simultaneously actuate the depending structures which are each cutting elements. Therefore, the design, function, and effects of the two devices are unconnected. Lastly, 37 CFR 1.141 permits the allowance of more a reasonable number of species given that there is an allowable claim generic to all the claimed species. This does not preclude a restriction requirement between the species, but allows the examiner to rejoin non-elected species that may depend from an allowed generic claim.

The requirement is still deemed proper and is therefore made FINAL.

Since the election of Species A was not accompanied by a listing of all claims readable thereon as required by MPEP § 809.02(a), the examiner has chosen claims 1-5, 10-13, and 17 to be readable on Species A.

Claim Objections

4. Applicant is advised that should claim 4 be found allowable, claim 11 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Similarly, should claim 5 be found allowable, claim 13 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10 and 17 refer to the flap as being a polygon. Despite the fact that the flap of the instant invention is actually made up of only 3 sides, one could imagine that the flap ends at a place similar to that of the dotted line in Figure 1, however the flaps of figures 4 and 8 have rounded corners which introduce a factor of flexibility with the term "polygon" making it unclear how broadly the term can be taken. It is suggested that a modifier such as "generally" or "substantially" be introduced to clarify the intended degree of variance to an actual polygon. For application of prior art, the broadest possible interpretation will be given to the term "polygon."

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2,847,759 to Jones.

Jones discloses the invention as claimed including a cutting device comprising: a base 24 having a guide edge 27 and an opening 26 with cutting edges; and a generally triangular flap 22 articulated with respect to the base, the flap having a shape corresponding to the opening and cutting edges corresponding to the cutting edges of the opening.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5, 11-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of US 3,315,753 to Cragg et al. (hereinafter Cragg '753) and US 4,573,576 to Krol.

Jones discloses the invention substantially as claimed, but is not mounted on a card that supports a medical device system for delivering a foam material. Cragg '753 teaches including a device 108 used for cutting in a kit including a medical device system for delivering a foam material, which allows tools used together to be available in a convenient manner. Therefore, it would have been obvious to include the cutter of Jones with a kit including a medical device for delivering a foam material since it would allow tools used together to be conveniently available. Though Figure 1 of Cragg '753 appears to show a kit as being mounted on a card, there is no support for a card in the

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specification; however, Krol teaches mounting a kit on a card to provide easy access to the tools within the kit. Therefore, it would have been obvious that the kit of Jones in view of Cragg '753 be mounted on a card to provide easy access to the tools of the kit.

Conclusion

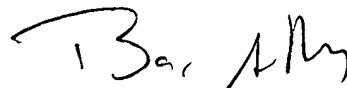
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lippincott, Hooe, and Seaman et al. are cited to show other examples of a device having a flap where an outer edge of the flap acts as a cutting edge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Druan, Jr. whose telephone number is 703-308-4200. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


tjd


BOYER ASHLEY
PRIMARY EXAMINER